

**REMARKS**

Claims 11-15 have been amended to resolve an issue raised by the Examiner under 35 U.S.C. §112, second paragraph. Withdrawn claims 7-9 have been amended in a similar manner so that this issue will not arise in the event they are rejoined with the elected claims. Claim 8 and the disclosure in the paragraph bridging pages 7-8 in the specification have been amended to correct an inadvertent error in the range for “u” by changing “0.1 to 9” to “0.1 to 0.9”, which can be seen from the disclosure at page 13, lines 10-11 (line 7 up to line 6 up on page 13). The claims have also been amended to make editorial changes.

Entry of the above amendments is respectfully requested.

**Rejection under 35 USC 112, Second Paragraph**

On page 2 of the Office Action, in paragraph 1, claims 11-15 are rejected under 35 USC 112 (second paragraph) as being indefinite.

In particular, the Examiner indicates that the statutory class of these claims is not clear (i.e., are they article claims or process claims like claim 10 upon which they depend?)

In response, Applicants have amended claims 11-15 to recite a heat-sensitive recording process rather than a heat-sensitive recording material to resolve this issue. Also, since non-elected claims 7-9 were previously amended to depend directly or indirectly on claim 10, Applicants have amended claims 7-9 to recite a heat-sensitive recording process rather than a heat-sensitive recording material.

Thus, Applicants submit that the present claims satisfy the requirements of 35 USC 112, second paragraph, and withdrawal of this rejection is respectfully requested.

### **Obviousness Rejections**

On page 2 of the Office Action, in paragraph 2, claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the Suzuki et al. patents for the reasons of record.

### **The Examiner's Position**

With respect to the Rule 132 Declaration filed with the response to the previous Office Action, the Examiner indicates that it does not make a comparison with the closest prior art. In particular, the Examiner indicates that while Suzuki et al. do not require an amide (e.g., stearic acid amide), they do require one to four modifications (see, e.g., column 5, lines 32-37 in Suzuki '507). Consequently, the Examiner takes the position that the comparative example in the Declaration should have employed one or more of modifications (2)-(4) as a comparison with modification (1) (i.e., use of stearic acid amide). The Examiner indicates that he would consider such a comparison after final rejection.

### **Applicants' Response**

In response to this rejection, Applicants submit that the present invention is not obvious because it provides unexpectedly superior results as can be seen from the supplemental Declaration under 37 C.F.R. § 1.132 submitted herewith.

The protective layers of the samples tested in the Declaration were prepared so as to include, to the greatest extent possible, the same ingredients as those of the Examples disclosed in Suzuki '507, except that a silicone modified acrylic resin was used instead of the silicone modified polyvinyl butyral resin described in Suzuki '507. Applicants believe that this change is necessary and permissible in view of the objective of the comparison test of the Declaration, and given that the protective layer coating solution of the present invention is water-based in contrast to the organic solvent-based protective layer coating solution of Suzuki '507.

As can be seen from Table 1 and the associated discussion on page 3 of the Declaration, Comparative Example 2 [which satisfied modifications (2)-(4) in column 5, lines 32-37 of Suzuki '507 but was outside the scope of the present invention because it lacked a stearic amide compound] did not provide good results with respect to sticking and noise, while Example 6 [which corresponded to Comparative Example 2 except that it was within the scope of the present invention because it included a stearic amide compound] exhibited superior head matching properties when used with a thermal head within the scope of the present invention.

Thus, Applicants submit that the present invention is not obvious because it provides unexpectedly superior results, and withdrawal of this rejection is respectfully requested.

## **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Application No.: 09/942,029

Attorney Docket No.: Q64677

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**23373**

CUSTOMER NUMBER

Date: April 19, 2004